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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.        | CONFIRMATION NO.       |
|---|-------------|----------------------|----------------------------|------------------------|
| 10/730,760  | 12/08/2003  | John A. Dyjach       | 279.663US1                 | 3450                   |
| 21186 7590 08/20/2007<br>SCHWEGMAN, LUNDBERG & WOESSNER, P.A.<br>P.O. BOX 2938<br>MINNEAPOLIS, MN 55402 |             |                      | EXAMINER<br>SMITH, TERRI L |                        |
|   |             |                      | ART UNIT<br>3762           | PAPER NUMBER           |
|   |             |                      | MAIL DATE<br>08/20/2007    | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|   |                                      |                                      |  |
|---|--------------------------------------|--------------------------------------|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | <b>Application No.</b><br>10/730,760 | <b>Applicant(s)</b><br>DYJACH ET AL. |  |
|   | <b>Examiner</b><br>Terri L. Smith    | <b>Art Unit</b><br>3762              |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED on 18 July 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: \_\_\_\_\_.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

  
 GEORGE R. EVANISKO  
 PRIMARY EXAMINER

8/16/07

Continuation of 11. does NOT place the application in condition for allowance because: with regard to Applicant's arguments, prosecution on the merits is closed. Consequently, claims 29-60 remain finally rejected as set forth in the Office Action mailed on 18 May 2007 because Applicant's arguments have been fully considered, but they are not persuasive.

Regarding Applicant's arguments against claim 29, Marcus et al., U.S. Patent 6,978,184 and Stone et al., U.S. Patent 6,208,409 (herein after referred to as Marcus et al. and Stone et al., respectively) disclose the structure that Applicant argues he is unable to find in the cited portions of the cited references as set forth in said Office Action in paragraphs 5-6 and repeated as follows: in Marcus et al., a CRM device and controller-FIG. 2, element 35-pacemaker (the controller being part of element 35 with the "adapted to" claim language as set forth in the present application being described in column 4, lines 39-52; ABSTRACT, lines 1-6 and 8; column 6, lines 8-9 and 17-20), a least one lead-element 36, a plurality of interface channels-column 5, lines 50-53, and a communication circuit-Figs. 3-5; elements 35 coupled with elements 42 and 41 where it is the Examiner's position that because the pacemaker transmits recorded data as shown by its communication through a programming head, 42, to the external pacemaker programmer, 41 (which is the programmer to program a CRM), it inherently has a communication circuit; column 10, line 64-column 11, line 44; Stone et al. disclose a plurality of electrodes on at least one lead (e.g., Fig. 7, elements 80-82 located in element H). It is noted that, where Examiner cited the figures without the claimed elements in said Office Action, it is the Examiner's position that one of ordinary skill in the art would be able to easily identify said elements; Examiner listed the specific elements in this Advisory Action to refute Applicant's argument.

All of the "adapted to" claim language is presented in the above cited portions of the Marcus et al. reference. As one example, "adapted to receive sensed cardiac signals" is shown at column 6, lines 16-20. Given that sensing information is accessed from the implantable pacemaker it is readily apparent that the implantable pacemaker does sense and subsequently transmit cardiac activity. Additionally, one of ordinary skill in the art would readily know that the sensed activity of the implantable pacemaker is obtained from the implantable leads attached to the heart. In Marcus et al., the sensed data that is manipulated by the SCG/ECG system is directly dependent upon signals sensed and directly obtained from the plurality of implantable leads of the implantable pacemaker. Therefore, a prescribed CRT as set forth in the claimed limitation cannot be negotiated without the pacemaker because information from the implantable pacemaker is required to perform the CRT. This is also depicted in great detail in FIGS. 1 and 3 as cited in said Office Action.

It is noted that it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Even though the Examiner maintains that the prior art of Marcus et al. and Stone et al. disclose the the claimed limitations set forth in the presently claimed invention as presented in said Office Action and as further shown herein, it is noted that said prior art need only have the ability to perform the functions because said prior art discloses the structure set forth in the presently claimed invention.

In response to Applicant's argument that Marcus et al. do not transmit recorded data to the external system from the implanted system (since the data is sensed and recorded externally), Examiner respectfully points to column 6, lines 13-20 which clearly teaches that the pacemaker transmits recorded data (i.e., the system 32 to receive marker channel diagnostic telemetry from the implanted pacemaker 35), with the recorded data being the occurrence of atrial events, both sense (AS) and pace (AP), and ventricular events, both sense (VS) and pace (VP).

On page 15 of the amendment filed on 18 July 2007, Applicant pointed to a portion of the specification for discussions about the use of the implantable device itself to sense and record the CRT-related data. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to the disputed terms. Applicant misinterprets the principle that claims are interpreted in the light of the specification.

Applicant's additional reasons for allowance regarding claims 34-41 fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Likewise, Applicants arguments against claims 49, 54 and 44 fail to comply with 37 CFR 1.111(b) as aforementioned herein.

Regarding Applicant's argument against Examiner's use of the language presented in paragraph 2 of said Office Action, Examiner once again respectfully reminds Applicant that, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. However, there is no requirement that a motivation to make the modification be expressly articulated (although Examiner did expressly articulate a motivation to make the modification in said Office Action on page 4, lines 5-10). The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. Further, when multiple references are used in a 35 U.S.C. 103 rejection, ninety-nine percent (99%) of the time there will always be conflicting elements between the references. The Examiner is not always relying on the conflicting elements to the stated references when meeting the claimed limitations of the application. In the instant case, Marcus et al. and Stone et al. are analogous art in that both contain an implantable cardiac rhythm management device (e.g., element 35-pacemaker and 71a-pacemaker, respectively), which is the device being claimed in the present invention. Additionally, as stated in the beginning of this Advisory Action of why this application is not in condition for allowance, Examiner has clearly cited where each claimed limitation is located in each art of record used for each rejection.